

REMARKS

Claims 1-21 are pending in the present application. Claims 1-21 are rejected. Claims 9-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including the relevant limitations.

In the Office Action mailed February 5, 2007, the Examiner rejected claims 5 and 6 under 35 U.S.C. §112 as failing to comply with the enablement requirement. The Examiner rejected claims 1-3, 7-8, 11, 13, and 16-21 under 35 U.S.C. §102(e) as being anticipated by US Patent 6,526,039 by Dahlman et al (hereinafter “Dahlman”). The Examiner rejected claims 4 and 14 under 35 U.S.C. §103(a) as being unpatentable over Dahlman in further view of US Pub. 2004/0100935 by Papageorngiou et al. (hereinafter “Papageorngiou”). The Examiner rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Dahlman. The Examiner rejected claim 15 under 35 U.S.C. §103(a) as being unpatentable over Dahlman in view of Papageorngiou and further in view of US Pub. 2004/0161020 by Mathew et al (hereinafter “Mathew”).

Applicant respectfully responds to this office action.

35 U.S.C. §112

Applicant respectfully traverses the Examiner’s rejection of claims 5 and 6 under 35 U.S.C. §112 as failing to comply with the enablement requirement. In paragraph [1058], the specification teaches that 15 hypotheses (for comparing) may be formed by mapping a selected peak to 15 frame offsets, in an example embodiment. That paragraph, and the several following paragraphs, teach various embodiments and the benefit of using such techniques. If one of skill in the art would not already be enabled to make and/or use the invention, a detailed technique suitable for creating such hypotheses is detailed in paragraph [1065]. In this paragraph, an integer multiple (W_T) of the number of chips in the slot (SLOT_SIZE) is added to a search result (NPOS). In light of these example selections of the specification, as well as the specification taken as a whole (including claims 5 and 6, which were included in the original filing), one of

skill in the art would surely be enabled to make and/or use the invention. Applicants request that the rejection of claims 5 and 6 be withdrawn.

35 U.S.C. §102

The standard for anticipation under §102 requires “the presence in a single prior art disclosure of all elements of a claimed invention arranged as in that claim.” *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 138, 231 U.S.P.Q.D (BNA) 644, 646 (Fed. Cir. 1998) (*quoting Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1101, 227 U.S.P.Q. (BNA) 337, 350 (Fed. Cir. 1985)) (*additional citations omitted*). The Examiner has failed to identify each and every claim limitation, and has therefore failed to set forth a prima facie case for anticipation as required by §102.

With respect to claims 1, 16, 20, and 21, Applicants respectfully disagree with the Examiner’s characterization of Dahlman. There are a variety of differences between that which is disclosed in Dahlman and the limitations of the present claims. For example, Dahlman does not teach removing a corresponding search result from the first plurality of search results when the search result offset is within a pre-determined threshold. On the contrary, Dahlman teaches comparing RTD estimates from a base station message with a matched filter output. When those comparisons indicate a match, Dahlman teaches initiating a search based on the matched peak. (See the Examiner’s cited portions of Dahlman, as well as c6:67 – c7:7.) Initiating a search on the match is clearly not consistent with removing a search result from a plurality of search results, and so Dahlman fails to disclose all the elements as required by §102. The rejection to claims 1, 16, 20, and 21, and to their dependent claims 2, 3, 7, 8, 11, 13, 17, 18 and 19 should therefore be withdrawn.

35 U.S.C. §103

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation of, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all the claim limitations.

For each §103(a) rejection in this Office Action, Applicants assert: the prior art of record does not provide a suggestion or motivation to modify the reference, there is not a reasonable expectation of success, and the reference does not teach or suggest all the claim limitations.

With regard to claims 4, 12, 14, and 15, each rejection relies on Dahlman for one or more claim limitations. Therefore the rejection to each of these claims should be withdrawn for the reasons given above with respect to 35 U.S.C. §103. Further, with respect to claim 12, since only the single reference Dahlman is used in the rejection, it appears that the Examiner is relying on personal knowledge to establish what would be known in the art. If so, Applicants request that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding per 37 CFR 1.104(d)(2).

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicant submits that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application is earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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